

Commissioner of Patents
Serial No. 10/813,817
Response Date July 17, 2006
Reply to Office Action dated May 16, 2006
Page 9

REMARKS

I. Status Of The Application

Claims 1, 3-13, and 30-35 are pending in the application. In the final Office Action dated May 16, 2006, the Examiner:

1. Rejected Claims 1, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Bernstein, et al.
2. Rejected Claims 2-10 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Bernstein, et al.; and
3. Noted that Applicant's Arguments filed on February 21, 2006 "have been fully considered but are not persuasive since Applicant is only claiming cards with various symbols/indicia which would be considered printed material and, as such, given no patentable weight."

In this response, the Applicants have canceled claim 2 and amended claims 1, 3-7. Applicants have also added new claims 30-35. Applicants note that the amended claims and the new claims 30-35, include no new matter and that support for the amendments and the new claims is found in the original specification.

Commissioner of Patents
Serial No. 10/813,817
Response Date July 17, 2006
Reply to Office Action dated May 16, 2006
Page 10

II. The Rejections of Claims 1, 11 and 12 Under 35 U.S.C. § 102(b) and Claims 3-13 Under 35 U.S.C. § 103(a) Have Been Overcome.

As an initial matter, Applicants want to thank the Examiner for the time she spent discussing this case and the very helpful guidance that she provided. Applicants believe that they have amended the claims consistent with that guidance and that the claims are now in condition for allowance.

In the Office Action, the Examiner stated her disagreement with Applicants' arguments from Applicants' February 21, 2006 Response to Office Action "since Applicant is only claiming cards with various symbols/indicia which would be considered printed matter and, as such, given no patentable weight." Applicants understand that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 U.S.P.Q. 401, 404 (Fed. Cir. 1983).

However, printed matter may well constitute structural limitations upon which patentability can be predicated. *Id.* at 405 (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *In re Gulack*, 217 USPQ at 404 (citing *In re Miller*, 418 F.2d 1392, 1396 (CCPA 1969).

As discussed above, Applicants have amended independent claim 1 to more particularly point out Applicants' invention and to clearly distinguish over the cited art. The functional relationship between the printed matter and substrate of Applicants' invention is neither found in the cited art nor obvious in view of the cited art. In Applicants' invention, the printed matter is

Commissioner of Patents
Serial No. 10/813,817
Response Date July 17, 2006
Reply to Office Action dated May 16, 2006
Page 11

functionally related to the substrate in that the substrate supports the printed matter and further in the particular sequence/arrangement of the printed matter on the substrate of Applicants' invention, which is not disclosed in the prior art. (See *In re Gulack*, 217 USPQ at 405.) Consequently, the cited prior art neither anticipates nor makes obvious Applicants' invention. Moreover, because claims 3-13 depend from allowable base claim 1, claims 3-13 are also allowable. (MPEP § 608.01(n))

III. New Claims 30-35 Are Not Anticipated Nor Made Obvious by the Cited Art.

Applicants have added new claims 30-35. No new matter has been added as new claims 30-35 find support within the specification as originally filed. Moreover, new independent claim 30 has a novel functional relationship between the printed matter and the substrate that is not disclosed in the cited art. The functional relationship between the printed matter and the substrate not taught in the cited art is the particular sequence/arrangement of the printed matter on the substrate. Consequently, Applicants' request allowance of new claim 30. Moreover, because new claims 31-35 depend from allowable base claim 30, claims 31-35 are also allowable. (MPEP § 608.01(n))

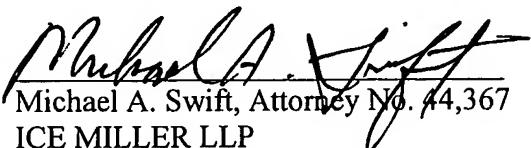
CONCLUSION

For all the foregoing reasons, it is respectfully submitted that Applicants have made a patentable contribution to the art and that this response places the above identified application in condition for allowance. Favorable reconsideration and allowance of this application is respectfully requested.

Commissioner of Patents
Serial No. 10/813,817
Response Date July 17, 2006
Reply to Office Action dated May 16, 2006
Page 12

In the event that Applicants have inadvertently overlooked the need to petition for an extension of time or for payment of a fee, the Applicants conditionally petition therefor, and authorize any fee deficiency to be charged to deposit account 09-0007.

Respectfully submitted,
ICE MILLER LLP


Michael A. Swift, Attorney No. 44,367
ICE MILLER LLP
One American Square, Suite 3100
Indianapolis, IN 46282-0200
(317) 236-2449
(317) 592-5453

MAS:jmh
Enclosure: Return Postcard